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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/522,085
Filing Date: March 10, 2000
Appellant(s): FOOTE ET AL.

Gregory A. Welte
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/04/2008 appealing from the Office action mailed 7/31/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,431,439	Suer et al.	08-2002
6,012,048	Gustin et al.	04-2000
5,940,811	Norris	08-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 22-23 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suer et al. (US Patent No. 6,431,439) considered with Norris (US Patent No. 5,940,811) or Gustin et al (US Patent No. 6,012,048).

As per claims 1-3, 8, 22-23 and 25-29 Suer et al disclose a system and method for enabling the electronic capture and storage of financial transactions. See the abstract. In so doing, Suer et al substantially teach the claimed invention. Suer et al disclose a user having an electronic portable device such as a personal digital assistant (PDA) for running various types of financial software(s) for conducting financial transactions with an ATM, point of sales (POS)

and other merchant computers. See column 3, line 54 to column 4, line 9 of Suer et al. Suer et al state that “the device may comprise a transceiver, e.g., such as an infrared (IR) transceiver, for wireless communication between the device and a terminal unit, such as a personal computer, an ATM, or a terminal at a merchant's site. An IR adapter may be plugged into the terminal unit's serial, parallel, Universal Serial Bus (USB), or IrDA port to receive data from the device. “ See column 4, lines 29-37 of Suer et al. Suer et al further state on column 6, lines 49-55 that “the user may enter ATM transaction information, such as a personal identification number (PIN) and a transaction amount, into the device 10 and transmit the information from the device 10 to the ATM 20 so that the user may perform ATM functions (e.g., withdraw money, transfer money between accounts, and deposit money) using the device 10”. From these descriptions, it is clearly seen that Suer et al disclose a method comprising an ATM which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands, and modifying the ATM to enable it to receive from a wireless device user commands for dispensing cash. Most ATM's are connected within a network. Suer et al do not explicitly state the portable device is a wireless telephone. The Examiner asserts that the device of Suer et al is a wireless device and that wireless devices include PDA's and cell phones and wireless phones. It would have been obvious to one of ordinary skill in the art at the time the invention was made to also include a wireless telephone device in the system of Suer et al in order to attract many types of users or customers having different types of portable devices. Furthermore, it is noted that the type of wireless devices being used therein would not affect the system of Suer et al since such is merely used for the purpose of facilitating wireless communication with another terminal.

Appellant's representative has amended their independent claims to recite wherein

- “ 1) the ATM, prior to modification, is operative to (A) respond to user commands, including a command to dispense cash, and (B) cause a modification to the user's account,
- 2) the ATM, before and after modification, is connected to a host computer via a network,
- 3) before the modification, other ATMs are connected to the host computer via the network,
- 4) the other ATMs are operative to respond to user commands, including a command to dispense cash,
- 5) all said ATMs are located in public places, and
- 6) at least some of the other ATMs are not modified to enable them to receive from a wireless telephone user commands dispensing cash. “

In response, it is noted that the appellant's claims are reciting inherent or obvious uses of an ATM and places or locations that ATMs are usually found. Furthermore, ATM's are usually connected within a network to a remote computer. The purpose of an ATM is to facilitate uses of banking functions that are commonly performed between a teller and a customer in a bank. An ATM facilitates these functions into an interactive function between a user and a automatic teller machine wherein the machine is usually placed in a public location. Furthermore, the language found in the present claims are within a “wherein clause” and is a recitation that is neither “steps or functions or structures” to be performed any functions. The claim as amended appears to recite intended use or descriptive language or arguments so as to overcome the art of record.

Furthermore, whether or not Suer et al recite that their ATMs before or after modification are or are not connected to a network or before or after modification, they are not being placed in a public place or before or after modification they do or do not respond to user commands, including a command to dispense cash and cause a modification to a user's account, the Examiner asserts that these are the usual functions of ATMs. ATM's usually respond to user commands, dispense cash, cause a modification to a user's account and are usually connected to a network. If any of the ATM's is subsequently modified to receive commands from a wireless telephone, then these ATM's would still continue to perform in the same manner before and after modification.

Appellant is referred to Norris or Gustin et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the ATM's of Suer et al in a network environment and in public locations in order to facilitate uses of the ATM's by remote customers not desiring to go to a bank in front of a human teller as in the system of Norris or Gustin et al.

As per claim 4, Suer et al teach the transceiver is further adapted to transmit signals directly to the portable device. See column 6, lines 44-47 where it is stated that "The device 10 may communicate various financial transaction data to and receive similar data from each of these terminal units".

As per claim 5, Suer et al teach the signals implement local wireless communication. See column 9, lines 29-46.

As per claim 6, most ATM's are connected in a network for enabling the checking of funds in a bank associated with the user. See also column 16, lines 25-37.

As per claim 7, see the above analysis, and column 16, lines 25-37 and column 10, lines 42-63 of Suer et al.

(10) Response to Argument

Appellant argues that Suer shows an ATM at a factory, in the process of being manufactured and cites column 4, lines 30 of Suer in stating that "an IR (infra-red) receiver may be attached to the "terminal" (the ATM), to allow communication with a customer's PDA (Personal Digital Assistant) and further states that Suer calls this "wireless communication" and the appellant concludes that Suer fails to teach:

The initial operative ATM

The modification of that operative ATM and

The resulting operative ATM which dispenses cash in response to commands from a cell phone.

In response, it appears that the Appellant is bringing up superfluous arguments in effort to convince the Board. In regard to the ATM being in a manufacturing plant or being manufactured, such an alleged teaching is not recited on column 4, line 30-42. The passage on column 4, lines 30-42 recites teachings of an improvement to allow communication between a portable device and an ATM machine. Furthermore Figure 1, elements 20 and 40 clearly illustrates an ATM and a POS terminal being in used or operative in regard to the invention of

Suer. In addition whether or not the ATM or POS of Suer was hinted to be inoperative, the functions and operations of an ATM machine and/or a POS terminal were old and well known before the appellant's invention. Such was also conventionally used in the art and in business. Thus, the appellant's argument that the initial ATM of Suer is inoperative is senseless and not persuasive. Regarding the appellant's statement that there is not a modification of an operative ATM, Suer clearly states on column 4, lines 30-42 that :

“In another aspect of the invention, the device may comprise a transceiver, e.g., such as an infrared (IR) transceiver, for wireless communication between the device and a terminal unit, such as a personal computer, an ATM, or a terminal at a merchant's site. An IR adapter may be plugged into the terminal unit's serial, parallel, Universal Serial Bus (USB), or IrDA port to receive data from the device. The device can thus, for example, transfer information about a financial transaction to accounting programs running on the PC. Because the IR adapter is part of the device, a separate cable does not have to be attached to and removed from the device. This allows the user to more quickly and easily communicate with the terminal unit. “

On column 6, lines 38-58, Suer et al states:

“FIG. 1 is a block diagram of a portable, hand-held information storage and transmission device 10 in accordance with the invention that may be connected to a plurality of remote terminal units, such as an automatic teller machine (ATM) 20, a host PC 30, and a point-of-sale terminal 40 located at a merchant's site. The portable, hand-held device may also be referred to as an information storage device. The device 10 may communicate various financial transaction data to and receive similar data from each of these terminal units. In

fact, the device 10 may be used with any computer-based system which can communicate data with the device. As discussed more fully below, the user may enter ATM transaction information, such as a personal identification number (PIN) and a transaction amount, into the device 10 and transmit the information from the device 10 to the ATM 20 so that the user may perform ATM functions (e.g., withdraw money, transfer money between accounts, and deposit money) using the device 10. The information about the ATM transaction is also stored on the device 10 so that this information can later be transmitted to a PC or other terminal units for later processing. “.

From these passage(s), the ATM must be fully operative, otherwise Suer would be misleading and if that is the case, the appellant must prove the allegation that Suer is misleading.

In that same recitation, Suer is also teaching the modification for allowing a PDA to communicate with an ATM or point of sale (POS) system.

Appellant also states that the resulting ATM system of Suer does not show an operative ATM which dispenses cash in response to commands from a cell phone.

In response, the examiner disagrees as Suer et al clearly state:

“FIG. 1 is a block diagram of a portable, hand-held information storage and transmission device 10 in accordance with the invention that may be connected to a plurality of remote terminal units, such as an automatic teller machine (ATM) 20, a host PC 30, and a point-of-sale terminal 40 located at a merchant's site. The portable, hand-held device may also be referred to as an information storage device. The device 10 may communicate various

financial transaction data to and receive similar data from each of these terminal units. In fact, the device 10 may be used with any computer-based system which can communicate data with the device. As discussed more fully below, the user may enter ATM transaction information, such as a personal identification number (PIN) and a transaction amount, into the device 10 and transmit the information from the device 10 to the ATM 20 so that the user may perform ATM functions (e.g., withdraw money, transfer money between accounts, and deposit money) using the device 10. The information about the ATM transaction is also stored on the device 10 so that this information can later be transmitted to a PC or other terminal units for later processing. “.

Appellant then argues that Suer uses a personal digital assistant (PDA) and that the claims recite a cell phone, or wireless telephone which orders an ATM to dispense cash. Appellant also states that the claimed device can make and receive telephone calls and get cash from the claimed ATM which is not present in Suer et al.

In response, Suer et al. use a PDA to command an ATM to perform usual banking functions of an ATM such as dispensing cash. The only difference between Suer et al and the claimed invention is that Suer et al make use of an ATM whereas the claimed invention makes use of a cell phone. It is noted that Suer et al clearly state that the portable device may comprise a transceiver such as an infrared (IR) transceiver for wireless communication between the device and a terminal unit such as a personal computer, an ATM or a terminal at a merchant's site. An IR adapter may be plugged into the terminal unit's serial, parallel, Universal Serial Bus (USB), or IrDA port to receive data from the device”. Thus, from this teaching, the device may be one

of a plurality of devices that can be communicated to an ATM or point of sales device once the IR or wireless structures are installed in both the portable device and the ATM or POS. In so doing, the Examiner asserts that the same IR as installed in a PDA can also be attached in a portable phone with the same likeness without undue experimentation. Likewise attaching wireless means to provide remote communication was old and well known in the art. Furthermore, it should be noted that claimed invention is not directed to the placing and receiving calls but is used as a communicating interface with an ATM or POS.

Appellant then states that the Examiner has not shown a wireless phone in Suer et al.

In response, one of ordinary skill in the art when viewing Suer et al would have been motivated to connect any one of a plurality types of portable devices such as a wireless phone to the ATM or POS in order to achieve the same result of remote communicating with the ATM or POS. Since wireless phones are more popular, it would have been obvious to one of ordinary skill in the art to substitute or add a portable phone in the system of Suer et al for marketing purposes.

Appellant then states that in regard to claim 2, there is not a program installed in the ATM of Suer et al.

In response, a program must be installed in the ATM or POS in order to allow communications and banking functions to take place with the remote portable device.

As per claims 3 and 25, Suer et al teach retrofitting the ATM or POS with a transceiver. See column 4, lines 29-42 of Suer et al.

As per claims 22-23 and 26-28, the ATM of Suer et al was not previously capable of receiving commands from a remote portable device. This is why Suer et al state installing an infrared transceiver in the ATM or POS and the portable device. See column 4 and 6 of Suer et al.

As per claim 29, in order for the PDA of Suer et al to communicate with an ATM or POS, communication must go through a network. Appellant is directed to figure 1 of Suer et al.

The appellant's statements that such is not shown in the reference are not convincing as the claimed limitations are taught and/or suggested by Suer et al.

The appellant then states that there is not an operative ATM shown in a public place, which dispenses cash being present in Suer et al.

In response, ATMs are usually intended to be placed in a public place having a high traffic volume which is beneficial to their owners because of the charges and fees imposed to clients who use them. Furthermore, their intended use is to dispense cash and to facilitate other related banking functions. Thus, even assuming Suer et al does not indicate such a statement, such a common use of ATM machine was in place prior to the appellant's invention. Otherwise, what is the purpose of an ATM?

Appellant's statement that there is not modification or retro-fitting of an operative ATM in the system of Suer et al is misleading. Appellant is directed to columns 4 and 6 and figure 1 of Suer et al.

Appellant's argument that there is no resulting ATM which dispenses cash in response to commands from a cell phone is not convincing as such is noted to be obvious when viewing Suer et al by the one of ordinary skill in the art.

Appellant then argues that there is not an expectation of success when modifying Suer et al. because a cell tower/satellite cannot communicate with the IR receiver of Suer et al.

In response, the appellant is directed to columns 4 and 6 and figure 1 of Suer et al. where Suer et al provide the means for modifying an ATM or POS to be used with a remote portable device. Incorporating the same installation structure in a portable cellular phone would have also been obvious to one of ordinary skill in the art as noted above as such would not teach away from Suer et al. It would be only an addition or a substitution the least to the system of Suer et al because portable phones are more commonly used than PDAs. Furthermore, the manner to modify Suer et al is the same as that indicated on page 3, line 21 to page 4, line 25 of the appellant's specification. In fact, the appellant's specification or drawing is absent of a cell tower/satellite communication system.

Appellant then argues that there exists a plurality of wireless devices and why one of ordinary skill in the art would choose a wireless phone to include in the system of Suer et al.

In response, Suer et al is directed toward a system and method to provide a user with a portable device to perform banking functions with an ATM. A remote car starter, a garage door opener or a model airplane remote control could have been used in the system of Suer et al but would have required an extra experimentation or additional work to bring these devices into a

smart device having sufficient memories, processor capabilities and speed to perform the functions already present in the portable device of Suer et al.

Appellant's representative then argues that the Examiner ignores their "wherein clause" or the Examiner does not give weight to their "wherein clause".

In response, the Examiner disagrees as the Examiner clearly provided an obviousness statement and has also provided the teaching of Norris and/or Gustin for noting teachings of these well known limitations.

Appellant's representative argues that the identifying step is not shown in Suer et al. In response, the Examiner disagrees because in the system of Suer et al, Suer et al did not claim to invent an automatic transaction machine (ATM). Instead, Suer et al improves functions to be used in conjunction with an ATM. By so doing, Suer et al inherently identify ATM's not having the capability to receive signals from a portable device. This is why Suer et al state in order for the portable device to communicate with an ATM or similar terminals, "An IR adapter may plugged into the terminal unit's serial, parallel, Universal Serial Bus (USB) or IrDA port to receive data from the device" see column 4, lines 24-38 of Suer et al.

Appellant's representative then argues that Suer et al do not teach or suggest modifying the ATM to receive from a wireless device user commands for dispensing cash.

In response, the Examiner again disagrees with the appellant's assertion. What is not stated in Suer et al is simply the word "modify" or "modifying". One of ordinary skill in the art is presumed to realize that by adding an IR adapter to enable a remote and wireless

communication between the portable device and an ATM, that this is an obvious function of modifying the ATM not having that previous function of enabling wireless communications.

Appellant's representative then argues that the problem with the Examiner's rationale in the prior Office action is that an unmodified ATM should have been present or should have been discussed by Suer et al and that no unmodified ATM is found in Suer et al.

In response, Suer et al disclose providing an IR adapter to an ATM or terminal. to do so, that ATM was not modified and by adding the IR adapter, the ATM or terminal then becomes a modified ATM being adapted to receive wireless communications for performing financial and banking transactions such as withdrawal and funds transfers. See column 6, lines 49-55 of Suer et al.

Appellant's representative then argues that Suer et al do not teach a wireless telephone user commands and that the Examiner's assertion that wireless devices include PDA's, cell phones and wireless phone is incorrect.

In response, appellant's comment that a wireless telephone is not a wireless device is not convincing. Wireless devices are devices that enable or that have the capability of performing communications with other devices or similar devices using non-direct or non-connected communications of wires or cables. Suer et al teach using IR adapters and transceivers and receivers. These are certainly wireless communications. Thus, appellant's comment is not persuasive.

Appellant's representative then concludes that because Suer et al state that an IR adapter may be plugged into the ATM's serial, parallel, USB or IrDA port, and therefore, Suer et al use the PDA as a wireless keyboard for the ATM.

It is unclear as to how the appellant is making such an assertion. The portable device described by Suer et al already includes a keyboard and special dedicated keys to perform specific functions. It is unclear as to why Suer et al would desire to go to the trouble of providing a wireless keyboard to perform the same functions that are already enabled in their portable device. Appellant's representative does not show where in Suer et al that such is suggested or taught. Appellant's further comments that no expectation of success has been shown as to how a wireless telephone can be used to issue signals to Suer's et al ATM is also not a sound statement.

Furthermore, it should be noted that the Examiner had never indicated that Suer et al teach a wireless telephone. The Examiner had stated that wireless devices include PDA'S and cell phones and wireless phones, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to also include a wireless telephone device in the system of Suer et al in order to attract many types of users or customers having different types of portable devices.

Furthermore, it is noted that the type of wireless devices being used therein is only one of plurality of type of wireless devices that would not affect the system of Suer et al since such would be merely used for the purpose of facilitating wireless communication with a terminal or ATM.

Appellant's representative then argues that Suer et al show a wireless device which engages in direct IR communication with an ATM and that such a device is not a generic class of devices which includes wireless telephones and concludes that Suer et al do not teach or suggest cellular telephones being engaged in direct communication with an ATM.

In response, the Examiner has never indicated that Suer et al teach a wireless telephone. The Examiner had indicated that Suer et al clearly teach a portable device communicating with an ATM or terminal or point of sales using wireless communications, and that providing a wireless telephone therein as an alternate wireless device would have been obvious to the one of ordinary skill in the art. It should be noted that the appellant is presumed to know more than what is disclosed in the prior art and the fact remains that wireless communications using cellular phones were well known in the art at the time of the appellant's invention. Thus, furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to also provide a wireless telephone in the system of Suer et al in order to provide a more flexible system adapted to receive a plurality of types of wireless devices.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3691

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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